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Stephane Jayet

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YOUNG & THOMPSON

209 Madison Street

Suite 500

ALEXANDRIA, VA 22314

EXAMINER

HAUPT, KRISTY A

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/530,203	Applicant(s) JAYET ET AL.	
	Examiner KRISTY A. HAUPT	Art Unit 2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 May 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-13 and 15-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-13 and 15-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 March 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This office action is in response to Applicant's Amendments filed 5/11/09. Claims 1, 3-13 and 15-23 are pending with claims 1 and 13 in independent form. Claims 2 and 14 are cancelled.

Claim Objections

1. Claim 22 is objected to because of the following informalities: Line 3 of Claim 22 states "said electronic component". There is a lack of antecedent basis for this in the claims from which claim 22 depends. It is believed that Applicant meant to state "said electronic circuit". Appropriate correction is required.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 13, 15 and 21-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Sloan US 6,273,335 B1 (as previously cited).

With respect to claim 13, a method of configuring a microcircuit card characterized in that it comprises the following successive steps:

- Personalizing said card (Column 6, Lines 8-34)

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- Receiving a command (Column 6, Lines 36-49 where the command to unlock/lock card is sent to smart card)
- Modifying at least one characteristic of the performance of the card on reception of said command (Column 6, Lines 36-49 where the smart card locks/unlocks an application after it receives the command to do so)

With respect to claim 15 and incorporating all limitations of claim 13:

- Wherein, during said modifying step, said at least one performance characteristic is determined as a function of a predetermined instruction received in said command (Column 6, Lines 36-49 where an application in a smart card is locked/unlocked after a command is sent instructing it to do so)

With respect to claim 21 and incorporating all limitations of claim 13:

- During said modifying step, the use of all or part of an electronic circuit of said card is allowed or prevented, reversibly or not (Column 6, Lines 36-49 where an application within a smart card device can be locked and prevented from use or unlocked and able to be used)

With respect to claim 22 and incorporating all limitations of claim 21:

- Wherein said electronic component is a cryptographic unit (Column 6, Lines 8-34)

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3. Claims 1, 5-7, 13, 16-17 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Armuzzi et al. EP 1 143 688 A1 (as previously cited)

Armuzzi teaches:

With respect to claim 1:

- A microcircuit card (Abstract) comprising means for receiving a command, means for modifying at least one characteristic of the performance of said card on reception of said command, the modification means being characterized in that they can be used after a step of personalization of said card (Page 2, Paragraphs 0010-0017, Page 3, Paragraphs 0026-0028 and Pages 2-3, Paragraphs 0029-0033) and cryptographic means for authenticating the sender of said command (Page 2, Paragraph 0006 where all information exchanged is encrypted)

With respect to claim 5 and incorporating all limitations of claim 1:

- Wherein said receiver means are adapted to receive said command in accordance with an SMS protocol (Page 2, Paragraph 0017 and Page 3, Paragraphs 0026-0028)

With respect to claim 6 and incorporating all limitations of claim 1:

- Wherein said means for modification of at least one performance characteristic are adapted to modify the size of a usable area of a physical memory of said card (Page 2, Paragraphs 0011-0012 and Page 3,

Paragraphs 0026-0028 where the data is stored in memory on the card, therefore the size of a remaining usable area of memory is decreased)

With respect to claim 7 and incorporating all limitations of claim 6:

- Wherein said modification of the size of a usable area of a physical memory is effected by creating (Page 2, Paragraphs 0011-0012 and Page 3, Paragraphs 0026-0028) where a new program is created in memory), destroying at least one specific file or by modifying the size of at least one specific file comprised in said physical memory

With respect to claim 13, a method of configuring a microcircuit card characterized in that it comprises the following successive steps:

- Personalizing said card (Page 4, Paragraph 0031)
- Receiving a command (Page 2, Paragraphs 0007 and 0017-0018)
- Modifying at least one characteristic of the performance of the card on reception of said command (Pages 2-3, Paragraphs 0026-0033)

With respect to claim 16 and incorporating all limitations of claim 13:

- Wherein said step of reception of a command conforms to an SMS protocol (Page 2, Paragraph 0017 and Page 3, Paragraphs 0026-0028)

With respect to claim 17 and incorporating all limitations of claim 13:

- Wherein during said modifying step, the size of a usable area of a physical memory of said card is modified (Page 2, Paragraphs 0011-0012 and Page 3, Paragraphs 0026-0028) where a new program is created in memory)

With respect to claim 20 and incorporating all limitations of claim 13:

- Wherein during said modifying step, the use of at least one software function of said card is allowed or prevented, reversibly or not (Page 2, Paragraphs 0011-0012, Page 3, Paragraphs 0026-0028 and Page 4, Paragraphs 0030-0031 where the downloaded software services can be used)

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1, 3-4, 9-11, 12-13, 15, 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sloan US 6,273,335 B1 (previously cited) in view of Lin et al EP 1 223 565 A1 (previously cited).

Sloan teaches:

With respect to claim 1:

- A microcircuit card including means for receiving a command and means for modifying at least one characteristic of the performance of said card on reception of said command (Column 6, Lines 36-49), the modification means being characterized in that they can be used after a step of personalization of said card (Locking/unlocking applications takes place after the card has been personalized (Column 6, Lines 8-35))

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- Means for authenticating the sender of said command (Abstract and Column 6, Lines 36-49 where the command includes the password and CID number of the owner of the card)

With respect to claim 4 and incorporating all limitations of claim 1:

- The modification means are adapted to determine said at least one performance characteristic as a function of a predetermined instruction received in said command (Column 6, Lines 36-49)

With respect to claim 9 and incorporating all limitations of claim 1:

- Wherein said means for modification of at least one performance characteristic are adapted to allow or prevent the use of at least one software function of said card, reversibly or not (Figure 8 teaches locking a specific application on a smartcard to prevent use of the application, where the application is software installed on the card)

With respect to claim 10 and incorporating all limitations of claim 1:

- Said means for modification of at least one performance characteristic are adapted to allow or prevent the use of all or part of an electronic circuit of said card, reversibly or not (Column 6, Lines 36-49 where an application within a smart card device can be locked and prevented from use or unlocked and able to be used)

With respect to claim 11 and incorporating all limitations of claim 10:

- Said electronic circuit is a cryptographic unit (Column 6, Lines 8-34)

With respect to claim 13, a method of configuring a microcircuit card characterized in that it comprises the following successive steps:

- Personalizing said card (Column 6, Lines 8-34)
- Receiving a command (Column 6, Lines 36-49 where the command to unlock/lock card is sent to smart card)
- Modifying at least one characteristic of the performance of the card on reception of said command (Column 6, Lines 36-49 where the smart card locks/unlocks an application after it receives the command to do so)

With respect to claim 15 and incorporating all limitations of claim 13:

- Wherein during said modifying step, said at least one performance characteristic is determined as a function of a predetermined instruction received in said command (Column 6, Lines 36-49 where an application in a smart card is locked/unlocked after a command is sent instructing it to do so)

With respect to claim 21 and incorporating all limitations of claim 13:

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- Wherein during said modifying step, the use of all or part of an electronic circuit of said card is allowed or prevented, reversibly or not (Column 6, Lines 36-49 where an application within a smart card device can be locked and prevented from use or unlocked and able to be used)

With respect to claim 22 and incorporating all limitations of claim 21:

- Wherein said electronic component is a cryptographic unit (Column 6, Lines 8-34)

Sloan fails to teach:

With respect to claim 1:

- Where the means for authenticating the sender of the command is cryptographic

With respect to claim 3:

- Wherein the cryptographic means comprises an authentication key

With respect to claim 12:

- Further comprises synchronization means adapted to verify that said command is unique

With respect to claim 23:

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- Verifying, prior to said modifying step, that said command is unique

However, Lin teaches:

With respect to claim 1:

- Where the means for authenticating the sender of the command is cryptographic (Page 3, Paragraphs 0033-0034 and Page 4, Paragraphs 0047-0049)

With respect to claim 3 and incorporating all limitations of claim 1:

- Wherein the cryptographic means comprises an authentication key (Page 3, Paragraphs 0033-0034 and Page 4, Paragraphs 0047-0049)

With respect to claim 12 and incorporating all limitations of claim 1:

- Further comprises synchronization means adapted to verify that said command is unique (Page 3, Paragraphs 0033-0034 and Page 4, Paragraphs 0047-0049)

With respect to claim 23 and incorporating all limitations of claim 13:

- Verifying, prior to said modifying step, that said command is unique (Page 3, Paragraph 0033)

Therefore, it would have been obvious to one of ordinary skill in the art to modify the invention of Sloan to authenticate the sender of the command

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cryptographically, as taught by Lin to eliminate the possibility for a rogue terminal to take over and avoid the potential danger of a third party searching a card from an exposed session, thereby enhancing security of the smartcard (Page 3, Paragraph 0034 and Page 4, Paragraph 0049).

5. Claims 8 and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sloan US 6,273,335 B1 (as previously cited) in view of Sato US 2002/0103891 A1(as previously cited).

The teachings of Sloan have been discussed above.

Sloan fails to teach:

With respect to claims 8 and 19:

- A clock frequency of the card is modified, reversibly or not (Figure 14 teaches changing the maximum operation clock speed where the contents of the management information storage area are rewritable, therefore can be changed multiple times

With respect to claim 18:

- During the modification of the size of a usable area of a physical memory at least one specific file included in the physical memory is created, or destroyed or the size of at least one specific file included in the physical memory is modified

However, Sato teaches:

With respect to claims 8 and 19:

- A clock frequency of the card is modified, reversibly or not (Also see Page 3, Paragraphs 0055, 0062 and 0076 and Page 5, Paragraphs 0102-0104))

With respect to claim 18:

- During the modification of the size of a usable area of a physical memory at least one specific file included in the physical memory is created, or destroyed or the size of at least one specific file included in the physical memory is modified (Page 6, Paragraphs 0125 - 0135)

Therefore, it would have been obvious to one of ordinary skill in the art to modify the invention of Sloan to allow a clock frequency to be modified, as taught by Sato, to allow the user to maximize the performance characteristics of the card to his own specifications depending on other conditions/modification he has made.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Applicant's Amendments now require that the means for authenticating the sender of the command are cryptographic. This limitation was not

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present in the previous set of claims. Accordingly, **THIS ACTION IS MADE FINAL.**

See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Response to Arguments

7. Applicant's arguments with respect to claims 1 and 13 have been considered but are moot in view of the new ground(s) of rejection.

Applicant argues that the prior art cited, Sloan (US 6,273,335 B1) does not teach cryptographic means to authenticate the sender of the command and if Sloan were modified to exchange cryptographic keys between two entities does not significantly secure the data transmission, because the cryptographic keys may be accessed by an eavesdropping third party, therefore it does not significantly increase transfer security of data (See Pages 13-14 of the Amendment filed 5/11/09). The Examiner disagrees. The Examiner's newly cited rejection (Sloan

as modified by Lin (EP 1 223 565 A1) teaches using a session key agreed upon by the smartcard and the device generated that it is impossible to determine a card key from the session key, thereby avoiding the potential danger of a third party searching a card from an exposed session (See Page 4, Paragraphs 0048-0049 of Lin).

Applicant also argues that the one skilled in the art would not combine the teachings of Sloan with the teachings of Lin as Lin is directed to a mutual authentication of a terminal and a smartcard for transaction purposes (See Page 15 of the Amendment filed 5/11/09). The Examiner disagrees. Both the prior art of Sloan and the prior art of Lin relate to smartcards, therefore one of ordinary skill in the art would have looked to other smartcard uses/technology for improvements and/or modifications.

Applicant argues that the combination of Sloan with Lin would, at best, have been a smart card adapted to cooperate with a device allowing the locking and unlocking of applications and adapted to operate a mutual authentication with a terminal prior to exchange data and the claimed invention would not be obtained. The Examiner disagrees. In the newly cited rejection, Lin is relied upon to teach the benefits of cryptographic transmissions of commands between a smartcard and a separate device. The Examiner has used these taught benefits to apply to the invention of Sloan, which as shown in the rejection, already teaches authenticating the sender of a command. These benefits, as applied to Sloan, would increase the security of the command transmissions between the

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smartcard and the device used to lock/unlock applications. Therefore, the combination of Sloan as modified by Lin would achieve the currently claimed invention.

Applicant argues these same points to the effect of independent claim 13, however it is noted that newly amended claim 13 does not require “cryptographic” means, as it now does in independent claim 1. Therefore, the previous rejection would still apply.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KRISTY A. HAUPT whose telephone number is (571)272-8545. The examiner can normally be reached on M-F 7:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kristy A Haupt/
Examiner, Art Unit 2876

/Michael G Lee/
Supervisory Patent Examiner, Art Unit 2876